IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

    Wiechers, et al.

Serial No.: 10/635,467

Filed: August 7, 2003

Group Art Unit: 2625

Examiner: Rodriguez, Lennin

Docket No. 200207420-1

For: **Managing Workflow In A Commercial Printing Environment With Pre-Submittal High Performance Automated Remote Proofing**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed July 15, 2008 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

A. No Disclosure of Generating a Press Ready File that "Encapsulates both [a] Print Job and [a] Job Ticket"

In Applicant's Appeal Brief, Applicant identified that, contrary to that alleged by the Examiner, Laverty does not in fact disclose "generating at the designer location a press ready file that encapsulates both said print job and said job ticket". During prosecution, the Examiner had relied upon column 10, lines 50-61 of the Laverty reference as disclosing the generation of such a press ready file. As was noted in the Appeal Brief, however, that portion of Laverty's disclosure is silent as to a file that "encapsulates both [a] print job and [a] job ticket".

On pages 13 and 14 of the Examiner's Answer, the Examiner reiterates his position that column 10, lines 50-61 describe a user generating a press ready file that encapsulates a print job and a print ticket. In reply, Applicant reiterates that such a disclosure is not provided in column 10, lines 50-61. Instead, that portion of Laverty's disclosure, which was reproduced in Appeal Brief, separately indicates that (i) a customer inputs data on a web site, and (ii) that a Print Ready File is created by "the system," which then "shows" the file to the customer. *See Laverty*, column 10, lines 50-61. Therefore, Laverty neither describes "generating" a press ready file "at the designer location" (i.e., the remote "system" creates the Print Ready File), or any component, whether it be the customer or the system, generating a file that "encapsulates both said

print job and said job ticket". In regard to the latter issue, although the Examiner apparently presumes that Laverty's Print Ready File includes both a print job and a job ticket, there is simply no support in Laverty's disclosure for such a conclusion. Moreover, there is nothing in the Laverty reference or any of the other cited references that would lead a person having ordinary skill in the art to perform such encapsulation.

On page 14 of the Examiner's Answer, the Examiner "clarifies" his position by also referring to column 7, lines 50-53 of the Lahey reference, which disclose a user creating a job ticket. Applicant wishes to clarify for the record that Applicant does not dispute that Lahey discloses a user creating a job ticket. Applicant respectfully asserts, however, that Lahey, as Laverty and Schorr, fails to disclose or suggest a file that "encapsulates both said print job and said job ticket". Lahey's disclosure of creating a job ticket does not change that fact.

B.   No Disclosure of the Claimed "Automated Preflight Module at a Designer Location Automatically Establishing a Link to the Print Service Provider Location and Obtaining Updated Device Configuration Information from the Print Service Provider Location Concerning the Production Devices Specified in Said Job Ticket"

In Applicant's Appeal Brief, Applicant noted that, contrary to that argued by the Examiner, Schorr does not in fact disclose "an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket". In particular, Schorr fails to disclose each of (i) an automated preflight module "at a designer

location", (ii) an automated preflight module at any location "automatically establishing a link to the print service provider location", and (iii) an automated preflight module at any location "obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket".

In answer to Applicant's point regarding the lack of disclosure of an automated preflight module "at a designer location", the Examiner argues on page 15 of the Examiner's Answer that "column 4, lines 1-60" and Schorr's disclosure "as a whole" provides a disclosure of an automated preflight module "at a designer location". In reply, as an initial matter, Applicant notes that if Schorr actually provided such a disclosure, the Examiner would be able to identify that disclosure with greater specificity than 60 lines of text or the Schorr disclosure "as a whole." Moreover, as noted in the Appeal Brief, Schorr's "preflight system 101," which the Examiner relies upon in addressing the various actions performed by Applicant's claimed automated preflight module, is clearly *separate from* Schorr's designer, i.e., the "print buyer 119" and his "client machine 121." *See Schorr*, Figure 1A. Furthermore, although Schorr describes discrete modules contained within the preflight system 101 that are downloaded to the client machine 121, Schorr does _not_ state that the entire preflight system is downloaded to that machine, nor does Schorr indicate that download of the entire preflight system is performed or even possible.

In answer to Applicant's point regarding the lack of disclosure of an automated preflight module "automatically establishing a link to the print service provider location" the Examiner again cites column 4, lines 29-37 of the Schorr reference and argues that a user manually establishing a link with a print service provider location equates to a

preflight module "automatically" establishing such a link. In reply, Applicant submits that such an interpretation takes away all meaning from the explicit claim term "automatically" and further contradicts Applicant's disclosure, which must be considered when interpreting claim terms. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part"). As is clear from Applicant's disclosure, the claimed automated preflight module establishes the link automatically without human intervention. If it did not, it could not reasonably be considered to be an "automated" module that "automatically" establishes a link.

Finally, in answer to Applicant's point regarding the lack of disclosure of an automated preflight module "obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket", the Examiner on page 15 of the Examiner's Answer argues that column 6, lines 41-65 of the Schorr reference describe matching a specification of a print job with information about printers at the print service provider. In reply, Applicant reiterates that Schorr does not meet applicant's claim language, which specifies obtaining information about particular production devices "specified in said job ticket". Schorr says nothing about a job ticket or devices specified in that job ticket in column 6 or elsewhere in Schorr's disclosure.

C.   **No Disclosure of an Automated Preflight Module "Automatically Performing an Automated Remote Proofing by (i) Comparing [a] Job Ticket with the Obtained Device Configuration Information to Determine whether all required Elements for Successful Processing of [a] Print Job are Present and (ii) Checking said Print Job and said Job Ticket for Errors"**

In Applicant's Appeal Brief, Applicant noted that, contrary to that argued by the Examiner, Schorr does not in fact disclose "said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors". In particular, Schorr discloses neither of subsections (i) or (ii).

Regarding the "comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present" limitation, Applicant notes that the Examiner provided no explicit · answer to the point expressed by Applicant in the Appeal Brief that Schorr does not disclose comparing a job ticket with device configuration information to determine whether all elements for successful processing are present. Applicant therefore respectfully submits that the Examiner has tacitly conceded that point.

Regarding the "checking said print job and said job ticket for errors" limitation, the Examiner, on pages 16 and 17 of the Examiner's Answer, argues that Schorr discloses checking a print job and a job ticket for errors in column 3, lines 18-23. In reply, Applicant notes that Schorr actually teaches in those lines that an "analyzer" compares "detected document elements" with a list of element in printer profiles. *Schorr*, column
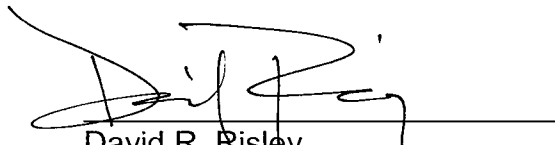
3, lines 18-23. To this point in prosecution of the instant application, the Examiner has not explained how that teaching is a disclosure of checking both a print job and a job ticket for errors. Indeed, the Examiner has not even explained his position as to which of a print job and a job ticket is comprised by the "detected document elements" described in column 3. Regardless, it is clear that Schorr's description of comparing "detected document elements" is not a disclosure of checking both a print job and a job ticket as is required by Applicant's claims.

Ostensibly in view of the weakness of the argument that Schorr actually discloses checking a print job and a job ticket for errors, the Examiner further cites the Lahey reference, which generally discusses job tickets. In reply, Applicant notes that Lahey's mention of job tickets is *not* tantamount to a disclosure of checking a print job and a job ticket for errors, and the Examiner has made no argument that Lahey's discussion of job tickets would motivate a person having ordinary skill in the art to check both a print job and a job ticket for errors. Indeed, even if one took the position that it would have been obvious to check a job ticket for errors in view of the Schorr and Lahey disclosures when taken in combination, there still would be no motivation to also check a print job (i.e., the document to be printed) for errors.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

David R. Risley
Registration No. 39,345